REMARKS

Claims 98-116 are currently pending in the above-identified patent application, claims 1-97 having been cancelled previously. Claims 98-100 are amended by this Response. Claims 107-116 have been withdrawn from consideration pursuant to a Restriction Requirement that has been made final. Accordingly, claims 98-106 are under consideration.

Claims 100 and 102-106 had been objected to under 37 C.F.R. § 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Claim 100 had been rejected under the second paragraph of 35 U.S.C. § 112 as being indefinite for lack of antecedent basis for the recitation of the limitation "the detection of the analyte."

Claims 100 and 102-106 had also been rejected under the second paragraph of 35 U.S.C. § 112 as being indefinite for being incomplete for omitting essential structural cooperative relationships of elements.

Claims 98-106 had been rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,554,531 to Zweig ("Zweig '531").

Claims 98-101 had been rejected under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over claims 1-3 and 5-8 of U.S. Patent No. 6,136,610 to Polito et al. ("Polito et al. '610").

Reexamination of the application as amended, reconsideration of the rejections, and allowance of the claims remaining for consideration are respectfully requested.

The three-month shortened statutory period for response expires on June 15, 2005. Accordingly, this response is being filed in a timely manner.

I. AMENDMENTS TO THE APPLICATION

The specification is amended to recite priority from previous application Application Serial No. 09/638,668, now abandoned.

The claims are amended to recite structure that performs the functions recited in claims 98-106, including detection of reflectance to determine the analyte. This structure is supported by the specification at page 29, lines 9-31.

Accordingly, these amendments introduce no new matter. Entry of these amendments is therefore respectfully requested.

II. THE REJECTIONS UNDER THE SECOND PARAGRAPH OF 35 U.S.C. § 112

A. The Rejection of Claim 100

Claim 100 had been rejected under the second paragraph of 35 U.S.C. § 112 as indefinite for recitation of the limitation "the detection of the analyte" as lacking antecedent basis. This basis for rejection has been obviated by amendment of claim 98 to refer to the detection of the analyte, thus providing antecedent basis for this phrase in claim 100. Accordingly, the Examiner is respectfully requested to withdraw this rejection.

B. The Rejections of Claim 100 and 102-106

Claims 100 and 102-106 had also been rejected under the second paragraph of 35 U.S.C. § 112 as being indefinite for being incomplete for omitting essential structural cooperative relationships of elements.

To the extent that amendments to claims 98 and 100 have not obviated this basis for rejection, these rejections are respectfully traversed.

These claims now recite sufficient structure, including functional connection between the elements, to be definite under the requirements of the second paragraph of 35 U.S.C. § 112. Claims are not production documents and do not have to recite an extraordinary level of detail. Claims need only to reasonably describe the claimed subject matter to one of ordinary skill in the art and to distinguish the claimed subject matter from the prior art. Rosemount, Inc. v. Beckman Instruments, Inc., 221 U.S.P.Q. 1 (Fed. Cir. 1984). That standard is met by the amended claims.

Accordingly, the Examiner is respectfully requested to withdraw this rejection.

III. THE OBJECTIONS TO THE CLAIMS UNDER 37 C.F.R. § 1.75(c)

Claims 100 and 102-106 had been objected to under 37 C.F.R. § 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim.

To the extent that this objection has not been obviated by amendment of claims 98-100, it is respectfully traversed.

Claim 100 now recites additional limitations of the apparatus recited in the claim. Limitations that limit a previous claim from which a dependent claim depends do not necessarily have to be structural limitations, but can also be functional limitations. They limit the subject matter of the claim from which they depend because a device meeting the limitations of the claim from which they depend, but that does not perform the specific function recited in the dependent claim, infringe the independent claim but not the dependent claim. This means that the dependent claim does limit the subject matter of the previous independent claim.

With respect to claims 102-106, the test strip is a structural limitation, and what the test strip contains is an additional structural limitation. Thus, there is no basis for an objection under 37 C.F.R. § 1.75(c) to these claims.

Accordingly, the Examiner is respectfully requested to withdraw this objection.

IV. THE REJECTIONS OF CLAIMS 98-106 UNDER 35 U.S.C. § 102(b) AS ANTICIPATED BY ZWEIG '531

Claims 98-106 had been rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,554,531 to Zweig ("Zweig '531").

To the extent that the amendments to these claims have not obviated this rejection, it is respectfully traversed.

Zweig '531 lacks any recitation of analysis of reflectance data from one or more sectors of the test strip as recited in claim 98. Zweig '531 is completely silent as to the analysis of reflectance data from sectors of the test strip, instead depending on an optical change over time. See column 9, lines 1-30, of Zweig '531.

This precludes any rejection under 35 U.S.C. § 102(b), as a rejection for anticipation requires that all claim limitations be present in a single reference. Verdegaal Bros. v. Union Oil Co. of California, 2 U.S.P.Q. 1051 (Fed. Cir. 1987).

The claims as amended do have structural limitations and recite functions associated with the structural limitations. Therefore, the comments in the Office Action at the last paragraph of Page 7 are inapposite as applied to the amended claims.

Accordingly, the Examiner is respectfully requested to withdraw this rejection as applied to the amended claims.

V. THE DOUBLE PATENTING REJECTION

Claims 98-101 had been rejected under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over claims 1-3 and 5-8 of U.S. Patent No. 6,136,610 to Polito et al. ("Polito et al. '610").

This rejection is respectfully traversed as applied to the amended claims.

This rejection is respectfully traversed because the requirements of claim 98 would not have been obvious from the subject matter of claims 1-3 and 5-8 of Polito et al. '610. The apparatus of claims 1-3 and 5-8 of Polito et al. '610 need not function in the way required by claim 98 of the present application; other methods of operation are possible. There is no recitation in the claims of Polito et al. '610 of detecting the analyte by analysis of reflectance data from one or more sectors of the test strip. Other methods of detecting the analyte were known in the art, such as by absorbance, fluorescence, or the measurement of an electrical property such as impedance. Accordingly, one of ordinary skill in the art would not have a reasonable probability of success in deriving the function or structure of the device of claim 98 of the present application from claims 1, 11-13, and 15-18 of Polito et al. '610.

The existence of obviousness-type double patenting requires that the invention defined in a claim in the pending application be an obvious variation of the invention defined in a claim of an earlier-issued patent. In re Berg, 46 U.S.P.Q. 2d 1226 (Fed. Cir. 1998).

Moreover, the analysis required for obviousness-type double patenting parallels that required for a determination of obviousness over prior art pursuant to 35 U.S.C. § 103. The absence of a reasonable probability of success in making the desired modification precludes any obviousness, and therefore any obviousness-type double patenting. See In re O'Farrell, 7 U.S.P.Q. 2d 1673 (Fed. Cir. 1988) (obviousness under 35 U.S.C. § 103).

Accordingly, the Examiner is respectfully requested to withdraw this rejection as applied to the amended claims.

VI. OTHER MATTERS RAISED IN THE OFFICE ACTION

The specification is amended to make specific reference to Application Serial No. 09/638,668, now abandoned, for the purpose of claiming priority under 35 U.S.C. § 120.

VII. CONCLUSION

In conclusion, all claims remaining for consideration particularly point out and distinctly claim that which Applicants regard as their invention. All dependent claims further limit the subject matter of the claims from which they depend. These claims are neither anticipated by nor obvious over the prior art, whether considered individually or in combination. These claims are also not subject to obviousness-type

double patenting. Accordingly, prompt allowance of these claims is respectfully requested.

If any issues remain, the Examiner is respectfully requested to telephone the undersigned at (858) 450-0099 x302.

Respectfully submitted,

Date: June 15, 2005

Michael B. Farber, Ph.D., Esq.

CATALYST LAW GROUP, APC
4220 La Jolla Village Drive, Suite 220
San Diego, California 92122
(858) 450-0099
(858) 450-9834 (Fax)